

REMARKS

Upon entry of this amendment, independent claim 22 with dependent claims 2-6 and 8-20 and independent claim 23 will be present in the application.

Claims 1 and 21 have been rewritten as claims 22 and 23, respectively, to more clearly recite the elements of the subject operation microscope. Claims 22 and 23 also include first and second observation beam paths that had not been recited in claims 1 and 21. The first and second observation beam paths are disclosed on page 7, lines 6-12. Claims 22 and 23 recite that the diaphragm is disposed within the illuminating beam path but not within the first and second observation beam paths. The position of the diaphragm relative to the beam paths 21 is shown in Figures 1 and 2. Claims 22 and 23 further recite that the front lens is disposed in the illuminating beam path and the first and second observation beam paths. The position of the front lens relative to the illuminating and observation beam paths is shown in Figures 1 and 2. Accordingly, the amendment does not introduce new matter. Claim 2-6, 8, and 11-14 have been amended to depend from new claim 22. Claim 14 has been amended to correct the deficiency noted in the Office Action. New claims 24-33 are equivalent to claims 3, 4, 6 and 8-14.

Claims 1, 2, 4, 5, 8-13, 16, 18 and 20 continue to be rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 4,671,631 (Sigelman). Claims 1, 8, 11, 13 and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated Japanese Patent 357115516A. Claim 21 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 5,512,965 (Snook).

New claims 22 and 23 each recite that: 1) the operation microscope includes first and second observation beam paths; 2) the diaphragm is disposed within the illuminating beam path but not within the first and second observation beam paths; and 3) the front lens is disposed in the illuminating beam path and the first and second observation beam paths.

With respect to the Sigelman reference, the illuminating beam path and the observation beam paths do not pass through a single front lens. More specifically, the observation beam paths provided by the optics of the Sigelman viewing system 16 are substantially parallel to the illuminating beam path after the light emitted by lamp 102 is reflected by mirror 86 and emitted from the light source assembly 14. At no point do the

illuminating beam path and the observation beam paths pass through a common element of the Sigelman apparatus. With respect to Japanese Patent 357115516A, Figure 6 clearly shows that the “diaphragm” 15 cited in the Office Action is in the observation beam path. With respect to the Snook reference, the illuminating beam path and the observation beam paths do not pass through a single front lens. More specifically, the illuminating beam path from the lamp 20 is parallel to the observation beam path of the camera 30 until mirror 52' directs the illuminating beam path toward the observation beam path. Mirror 52 then redirects the illuminating beam path to be parallel to the observation beam path. As shown in the figures of the Snook reference, there is no lens disposed in both the illuminating beam path and the observation beam path. Since none of the cited references discloses each and every element recited in claims 22 and 23, the apparatus disclosed therein cannot be anticipated by such references.

Claims 1-6, 8-12, and 14-20 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. 5,258,791 (Penney) in view of Sigelman. As shown above, Sigelman does not disclose a system having a front lens in both the illuminating beam path and the observation beam path(s). The Penney reference suffers from a similar deficiency. As shown in Figure 4 (cited in the Office Action), the last, and only optical element of the Penney device that is common to both the “projecting portion” and the “sensing portion” is a polarizing beam splitter. Penney teaches that “[o]n emerging from the cornea, the rays of light will be parallel for an eye having optimum refraction. This emergent beam of light then enters the sensing system 150 by striking the surface of the beam splitter 168 which reflects the horizontally polarized portion of that light toward a photodetector 172.” Clearly, beam splitter 168 is not a lens. Therefore, neither the Sigelman reference nor the Penney reference disclose the front lens of the subject device.

MPEP § 706.02(j) states “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See also MPEP §§ 2142 and 2143. Neither the Sigelman reference nor the Penney reference disclose all of the elements recited in claims 1-6, 8-12, and 14-20, accordingly the rejection under 35 U.S.C. § 103 must be withdrawn. Further, none of the references cited in the Office Action, teach or suggest all of the claim

limitations of the subject claims. Therefore, the claims may not be rejected under 35 U.S.C. § 103(a) as being obvious over Japanese Patent 357115516A or Snook.

The various dependent claims add additional features to the independent claims, and are therefore believed to be allowable. Also, the dependent claims are believed patentably distinct on their own merits as being directed to combinations not suggested by the references.

In view of the above-directed amendments and the proceeding remarks, prompt and favorable reconsideration is respectfully requested.

Respectfully submitted,
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